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1 RECORD OF ORAL HEARING
2 UNITED STATES PATENT AND TRADEMARK OFFICE

3
4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

7 *Ex parte* STEPHAN HUEFFER, STEFAN SCHROEDER,
8 EINHARD WAGNER, THORSTEN RADLER and KARL VILL
9

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11 Appeal 2009-014067
12 Application 10/524,047
13 Technology Center 1700
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16 Oral Hearing Held: March 11, 2010
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19 Before CHARLES F. WARREN, TERRY J. OWENS and
20 MARK NAGUMO, *Administrative Patent Judges*
21

22 ON BEHALF OF THE APPELLANT:

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1 JUDGE WARREN: Good afternoon, Mr. Doughty.

2 MR. DOUGHTY: Hello.

3 JUDGE WARREN: Mr. Jablonsky is with us today as the court
4 reporter. Could you please provide him with a card, sir?

5 MR. DOUGHTY: Yes, indeed.

6 JUDGE WARREN: And any other information you may
7 require.

8 (Discussion was held off the record.)

9 JUDGE WARREN: As you know, Mr. Doughty, you have 20
10 minutes. And you'll begin when ready.

11 MR. DOUGHTY: Thank you.

12 May it please the Board. My name is Jacob Doughty, and I
13 represent Stephan Heuffer and his co-inventors, who are the Appellants in
14 this matter.

15 For the purpose of my discussion today, I'm going to focus on
16 Claim 32, the only independent claim as it pertains to the four outstanding
17 obviousness rejections.

18 Claim 32 is directed to a method for tanning, in which an
19 animal hide is contacted with a particular formulation. The formulation
20 includes a clay mineral and one or more additional reagents, such as tanning
21 reagents.

22 The clay mineral is a phyllosilicate selected from kaolinite,
23 smectite, muscovite, montmorillonite, bentonite, and hectorite.

24 I want to focus in particular on the claim on the size
25 requirement. Claim 32 requires that the clay mineral has a number average
26 particle diameter of less than 2 microns, or alternatively, the clay mineral has
27 a bimodal size distribution with the first fraction having a number average
28 particle diameter of less than 0.5 microns, and a second fraction having a
29 number average particle diameter of less than 5 microns.

30 I'm going to turn first to the rejection over Komforth and
31 Cramer. Komforth discloses compositions for retanning and fatliquoring
32 leather.

1 The compositions can optionally include kaolin as a carrier. But
2 there are no examples in Komforth in which kaolin is used. Komforth fails
3 to disclose that the kaolin carrier should have any specific particle size,
4 much less the particle size that's in Claim 32.

5 Cramer is the reference that the Examiner relies on to overcome
6 this deficiency of Komforth. Cramer discloses coating compositions that
7 may include clay nanoparticles. The nanoparticles can have a particle size
8 of from 2 to 750 nanometers.

9 Cramer uses nanoparticles and coatings for materials. And the
10 materials that can be coated, one of the ones that's mentioned is leather.
11 However, coating leather is different than chemically altering a hide to
12 produce leather.

13 There's no indication in Cramer of why nanoparticles of a
14 particular size that are disclosed in Cramer would have any usefulness in a
15 retanning or fatliquoring composition.

16 Cramer's indication that nanoparticles are good for coating does
17 not suggest that they would also be good for retanning and fatliquoring.

18 I think the point I just wanted to make vis-a-vis the prima-facia
19 case here and with the other ones, is that the secondary references clearly are
20 advocating that their constituents have value, that, you know, almost every
21 patent says what we have here is good stuff.

22 But just saying that it's good in this particular context doesn't
23 necessarily mean that it would also be good in this different context, which
24 is in the primary reference.

25 JUDGE NAGUMO: Don't we have a general teaching of that,
26 though, in Komforth?

27 MR. DOUGHTY: Mm-hmm.

28 JUDGE NAGUMO: Use kaolin? Any kind of kaolin --

29 MR. DOUGHTY: Sure, but --

30 JUDGE NAGUMO: -- goes out and finds nanoparticles made
31 of kaolin, and says, "Well, here's a nanoparticle made of kaolin." Is it in

1 Komforth, of a reasonable expectation that it will behave like the other
2 kaolins?

3 MR. DOUGHTY: I mean, perhaps. But I mean, I think
4 looking at Komforth itself, I don't think that there's any indication that that's
5 the case.

6 And the mention of kaolin, I mean, there's certainly no
7 indication that particle size would have any effect, whatsoever. So there's no
8 guidance by which you would select the particular size profiles that are in
9 the claims of the present application.

10 JUDGE NAGUMO: Well, all we need is less than 2 microns,
11 and that's certainly met by 750 nanometer kaolin particles.

12 MR. DOUGHTY: Sure.

13 JUDGE NAGUMO: So that -- isn't very hard to meet. And all
14 you need is a reasonable expectation of successfully using a material, a type
15 of material that's generally taught --

16 MR. DOUGHTY: And I guess -- I'm sorry?

17 JUDGE NAGUMO: Why wouldn't that establish the prima
18 facie case that you'd have to come forward and say, "Well, look at our better
19 results"?

20 MR. DOUGHTY: Well, I guess the reason that I think that it
21 wouldn't is because the 750 nanometers, that's in the second reference. So I
22 mean, I guess I'm not sure of your position.

23 Are you saying that based on just the sole disclosure of kaolin
24 in the primary reference, that that would be enough to select any size? Is
25 that sort of the position that you're advocating? Or --

26 JUDGE NAGUMO: Well, there might be some disclosure that
27 refers to some size as being -- you know, don't use something in this size
28 range.

29 MR. DOUGHTY: Mm-hmm.

30 JUDGE NAGUMO: That might be something that is evident to
31 a person of skill in the art. Now is there any evidence like that in this
32 record?

1 MR. DOUGHTY: I'm not aware of any evidence particularly in
2 Komforth itself that is discouraging you from using any particular particle
3 size.

4 The flip-side of that is there is no affirmative suggestion that
5 one is any better than the other. So optimizing the particle size, I mean,
6 there's really no basis from which to expect that selecting any particular one
7 would be better than any other.

8 So I guess my point would be that there's nothing affirmative
9 that would lead a skilled artisan to pick the particular particle size.

10 So there's no prima facie basis for selecting this particular
11 particle size.

12 And just sort of adjunct to this, I mean, I have rebuttal evidence
13 too that I also might discuss, or in the context of all of them. But that would
14 be my position.

15 JUDGE NAGUMO: Okay. Proceed. Go ahead.

16 MR. DOUGHTY: Thank you.

17 The second rejection I wanted to talk about is Komforth and
18 Zorn. And basically this is a similar construct here. Komforth is the
19 primary reference relied on for the same reasons that it's relied on in the
20 previous rejection.

21 However, Zorn, instead of disclosing a coating, discloses this
22 filling composition. And this is a composition that may have a particle size
23 of 0.05 to 50 microns, which overlaps the range in the present claims.

24 Komforth discloses using kaolin as the carrier, and Zorn
25 discloses kaolin in filling compositions with a dispersing agent. In Zorn, the
26 dispersing agent becomes insoluble and fixes the filler to a tanned leather.

27 The Examiner hasn't demonstrated why a skilled artisan would
28 expect that the fillers used in Zorn would be useful or even operative in a
29 retanning or fatliquoring composition, as in Komforth.

30 So again, Zorn's suggestion that particular fillers are useful in a
31 filling composition doesn't suggest that they would also be useful in a
32 retanning or fatliquoring composition.

1 The second primary reference is the Plapper reference. And the
2 first rejection over Plapper is over the combination of Plapper and Cramer.

3 Plapper discloses compositions for tanning. The compositions
4 in Plapper may include aluminosilicates that have particle sizes of 0.1
5 microns to 5 mm.

6 Plapper doesn't disclose phyllosilicates having any particular
7 size. The only phyllosilicates that are disclosed in Plapper are kaolin, which
8 is used as a precursor. Plapper discloses deconstructing it before you're
9 actually using it in the composition.

10 And bentonite, which is added in the examples to the disclosed
11 aluminosilicates, is not indicated to have any particular size. And the
12 combination of bentonite and the aluminosilicates that are disclosed in
13 Plapper, together have a combined particle size that's larger than recited in
14 the present claims.

15 Cramer discloses, as we discussed, for coating compositions.
16 And I would make the same position as with regard to the rejection over
17 Komforth in Cramer. Basically the utility of these nanoparticles in a coating
18 composition doesn't suggest their usefulness in a tanning composition.

19 And that takes us to the fourth obviousness rejection. And
20 that's over Plapper and Christner. The examiner relies on Christner as an
21 alternative to Cramer, to overcome the deficiencies in Plapper with respect
22 to the particle size of the recited phyllosilicates.

23 Christner discloses liquid enzyme compositions that are used in
24 the production of leather. The liquid enzymes compositions may include
25 clay, such as bentonite. And the clays can have a particle size of from 0.05
26 to 5 microns.

27 While Christner indicates that the disclosed clays may prevent
28 creaming and settling -- these are problems that are specific to liquid enzyme
29 compositions -- there's no indication in Christner that the fillers of the
30 particular particle size will provide similar desirable effects in the chemical
31 tanning compositions of Plapper, which don't include enzymes.

1 JUDGE OWENS: But it teaches that the 0.5 to 5 micron range
2 is a commercial grade. Why wouldn't you use a commercial grade?

3 MR. DOUGHTY: I guess not knowing precisely what is meant
4 by "commercial grade." I mean, a commercial grade for a particular
5 application? Or a commercial grade for all applications?

6 I mean, there's still not specificity, as to, you know, what is that
7 particular commercial grade's usefulness.

8 I mean, I guess the assumption that you can use this commercial
9 grade to sort of stabilize these enzyme compositions, again, our position is
10 that it wouldn't suggest that you could also use it in the particular application
11 that we're talking about.

12 JUDGE OWENS: It seems like it would mean that it's available
13 commercially.

14 MR. DOUGHTY: Oh, I don't dispute the availability of it. I
15 mean, that --

16 JUDGE OWENS: Possibly not reagent grade.

17 MR. DOUGHTY: Mm-hmm.

18 JUDGE OWENS: Just maybe an industrial grade that's
19 available. Why wouldn't you use that?

20 MR. DOUGHTY: I guess, I mean, I don't have a reason why
21 you necessarily wouldn't use it. But our position is that there is no, you
22 know, affirmative suggestion in the references that you should use it in the
23 particular context that we're talking about in our claim and in the primary
24 reference.

25 I want to turn just for a minute or two to the data in the present
26 specification. The examples of the present specification demonstrate that
27 selecting particle sizes as recited in the present claims, provide superior
28 results, when the particular composition, like the phyllosilicates in Claim 32
29 are used in a tanning context and a retanning context.

30 I commend you to tables 1, 2, and 3, in the present
31 specification, which show this improved performance for the exemplary
32 composition.

1 The Examiner in the Examiner's Answer doesn't address the
2 weight of the data at all in our position. The Examiner merely makes sort of
3 a summary statement that the data are not commensurate in scope with the
4 claims.

5 The examples in the present specification, they include four
6 exemplary clay minerals that are within the scope of Claim 32. And there is
7 a variety of different particle sizes for exemplary clay materials that are
8 outside the scope of Claim 32.

9 We believe that the examples include sufficient data, so that a
10 skilled artisan can reasonably extent the probative value of those examples
11 to the full scope of Claim 32; but more importantly, we don't believe that
12 there's anything in the record that would provide a basis for assuming that
13 the results would not be more widely applicable.

14 Are there any questions?

15 JUDGE WARREN: No questions. No further questions,
16 Counsel. Thank you for coming.

17 MR. DOUGHTY: Thank you very much.

18 Whereupon, at 1:55 p.m., the proceedings were adjourned.

19 * * * * *